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GOOGLE INC.

19 **UNITED STATES DISTRICT COURT**

20 **DISTRICT OF NEVADA**

22 Unwired Planet LLC,
23 Plaintiff,

24 vs.

25 Google Inc.,
26 Defendant.

Case No. 3:12-cv-504-MMD-VPC

**UNOPPOSED MOTION TO MODIFY
STAY OF DISCOVERY**

27 **AND RELATED COUNTERCLAIMS**
28

1 Google submits this unopposed motion to modify the stay of discovery in this case
2 (ECF No. 233 and ECF No. 472) for the limited purpose of serving the third-party document
3 subpoenas attached hereto as Exhibits A to C. The subpoenas are targeted to relevant, recently-
4 created documents concerning the sale of the patents at issue in this litigation. Because the
5 documents are in the possession of third parties, it is appropriate to modify the existing stay to
6 permit the attached subpoenas and ensure the preservation of these documents. The parties have
7 met and conferred, and Plaintiff Unwired Planet LLC (“Plaintiff”) does not oppose the requested
8 relief. Plaintiff reserves all of its rights to make objections to the subpoenas after the subpoenas
9 are served.

10 **I. BACKGROUND**

11 Plaintiff’s Complaint alleged infringement of ten patents. Discovery as to three of
12 those patents was stayed pending proceedings in the Patent and Trademark Office (“PTO”). ECF
13 No. 233 at 12. All seven of the remaining patents, as well as two of the three stayed patents, were
14 subsequently dismissed. ECF No. 371; ECF No. 451 at 7; ECF No. 472. The claims that remain
15 pending in this Court are Plaintiff’s claim of infringement for one of stayed patents, United States
16 Patent No. 7,024, 205 (the ’205 patent), as well as certain counterclaims. Pursuant to the Court’s
17 August 8, 2015 Partial Final Judgment, discovery and case deadlines as to the ’205 patent remain
18 stayed. *See* ECF No. 472.

19 On June 30, 2016, Plaintiff’s previous owner, Great Elm Capital Group, Inc.
20 (formerly Unwired Planet, Inc., and referred to herein as “Great Elm”) closed its sale of its
21 intellectual property business, including its ownership of Plaintiff, which in turn owns the patents
22 asserted in this case, to Optis UP, LLC, a subsidiary of PanOptis Holdings LLC. Ex. D. As
23 explained in Great Elm’s proxy statement filed with the SEC on May 25, 2016, the sale was the
24 culmination of a months-long process of Great Elm shopping the intellectual property assets of
25 Plaintiff to various potential purchasers. Ex. E at 26-31. In conjunction with the sale process,
26 Great Elm was advised by a firm called Black Stone IP to provide a valuation analysis of those
27 intellectual property assets and present them to the board of Great Elm. *Id.* at 31.

1 The parties have met and conferred regarding the preservation of documents
 2 associated with the transaction. Plaintiff has stated that “most, if not all, of the documents” are
 3 “not in the possession, custody, or control of Unwired Planet LLC,” but rather, were retained by
 4 Great Elm and Black Stone IP. Ex. F. Google also sent letters to Great Elm and Black Stone IP,
 5 requesting confirmation that relevant documents relating to the valuation and sale of Plaintiff’s
 6 intellectual property (including the patents in suit) were being preserved. Ex. G, H. Neither Great
 7 Elm nor Black Stone IP responded. Gratzinger Decl. ¶ 3.

8 **II. ARGUMENT**

9 The Court has the inherent power to modify its stay order to allow for the limited
 10 discovery sought by Google. The current stay pending PTO review of the ‘205 patent is
 11 discretionary, and arose from the Court’s inherent authority to manage its own docket. *See*
 12 *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988) (“Courts have inherent power to
 13 manage their dockets and stay proceedings, including the authority to order a stay pending
 14 conclusion of a PTO reexamination.”). As a necessary consequence, the Court also has the
 15 inherent power to lift or modify that stay. *See, e.g., World Chess Museum, Inc. v. World Chess*
 16 *Fed’n, Inc.*, No. 2:13-CV-00345-RCJ, 2015 WL 2185997, at *2 (D. Nev. May 7, 2015)
 17 (modifying stay pending parallel proceedings to permit limited discovery).

18 The stay should be modified because the documents sought by Google are
 19 potentially relevant to Plaintiff’s damages claims related to its claim for infringement of the ‘205
 20 patent. *See, e.g., Oracle Am., Inc. v. Google Inc.*, No. C 10-03561 WHA, 2012 WL 877125, at *3
 21 (N.D. Cal. Mar. 15, 2012) (“Fair Value” analysis of patent portfolio prepared in connection with
 22 patent acquisition was relevant to reasonable royalty analysis). Plaintiff has taken the position that
 23 the documents are for the most part not in its possession, custody, or control, and the third parties
 24 have not been responsive. Limited discovery through targeted third-party document subpoenas is
 25 therefore an efficient and effective way to ensure that the documents are preserved. *See, e.g.,*
 26 *Ervine v. S.B.*, No. 11 C 1187, 2011 WL 867336, at *2 (N.D. Ill. Mar. 10, 2011) (authorizing the
 27 issuance of limited third-party discovery prior to identification of plaintiff, and noting that receipt
 28 of subpoenas will put third parties on notice of their document preservation obligations).

1 **III. CONCLUSION**

2 For the foregoing reasons, Google respectfully requests that the Court grant this
3 unopposed motion to modify the stay orders at ECF No. 233 and ECF No. 472 to permit Google to
4 issue the third-party document subpoenas attached hereto as Exhibits A to C.

5
6 DATED: July 29, 2016

MUNGER, TOLLES & OLSON LLP

7
8 By: /s/ Peter E. Gratzinger

Peter E. Gratzinger

9 Attorneys for Defendant Google Inc.

10
11
12 IT IS SO ORDERED:

13 

14 UNITED STATES DISTRICT JUDGE

15
16 Dated: August 2, 2016

Exhibit H

[Letter from Google's counsel to Black Stone IP (June 22, 2016)]

Exhibit H

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June 22, 2016

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Via EXPRESS MAIL

Elvir Causevic
Chief Executive Officer
Black Stone IP
71 Stevenson Street, Suite 800
San Francisco, CA 94015

Re: *Unwired Planet LLC v. Google Inc.*, No. 12-cv-504 (D. Nev.)

Dear Mr. Causevic:

My law firm represents Google in the above-referenced litigation with Unwired Planet LLC. In this letter, we refer to Unwired Planet, Inc., Unwired Planet LLC, and related entities, as "Unwired Planet." We understand that you met with Unwired Planet executives in November 2015, and Unwired Planet subsequently retained your firm to advise regarding the valuation and sale of Unwired Planet's patent licensing business. We write regarding the preservation of certain documents that are likely to be relevant to the ongoing litigation between Unwired Planet LLC and Google.

Documents likely to be relevant to Unwired Planet LLC's claims against Google include (1) documents that Unwired Planet made available to Black Stone IP relating to the value

MUNGER, TOLLES & OLSON LLP

Elvir Causevic
June 22, 2016
Page 2

of its IP portfolio, (2) written communications between Black Stone IP and Unwired Planet, (3) Black Stone IP's notes of communications with Unwired Planet management, and (4) Black Stone IP's analyses, draft reports, and final reports. Please confirm that Black Stone IP is preserving all such documents and will continue to do so during the pendency of the litigation between Google and Unwired Planet LLC.

We look forward to your prompt reply. As I will be on vacation from June 27 – July 8, please do not hesitate to reach out to my colleague, Adam Lawton, at (213) 683-9105.

Very truly yours,

A handwritten signature in black ink, reading "Peter Gratzinger". The signature is fluid and cursive, with the first name "Peter" and last name "Gratzinger" clearly distinguishable.

Peter E. Gratzinger

cc: Adam Lawton



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Travel History

Date/Time	Activity	Location
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3:52 am	At destination sort facility	SAN FRANCISCO, CA
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2:11 pm	Shipment information sent to FedEx	

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Weight	0.5 lbs / 0.23 kgs	Delivered To	Receptionist/Front Desk
Total pieces	1	Total shipment weight	0.5 lbs / 0.23 kgs
Terms	Shipper	Shipper reference	28082-00002-Gratzinger
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